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## D. REMARKS

### *Claims Status*

Claims 1-30 are currently pending in the application. Claims 1, 2, 5, 9, 12, 13, 15, 18-20, 22, and 25-30 are amended.

### *Interview Summary*

In a telephone interview on December 13, 2005 at 1 PM EST, Applicants' representation, Amy Pattillo, and Examiner Duong discussed the following items related to the rejection of claims 1, 5, 6, 7, and 13 in view of Votipka (US Patent 6,185,589). No exhibits were shown or demonstrations performed.

Applicants requested clarification whether the 101 rejection would be withdrawn in view of recent changes to office policy. The Examiner noted that Office Policy has changed yet again and that in view of the new changes to the Office Policy, the 101 rejection remains. Applicants contacted the Examiner on December 14, 2005 and requested that the Examiner provide a specific reference to the policy that supports the 101 rejection. The Examiner directed Applicants to a publication available on the Patent and Trademark Office website titled "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility".

Applicants requested clarification in claim 1 of how Votipka teaches determining whether there is available white space. The Examiner continues to assert that Votipka's disclosure of determining the width of a display area teaches determining whether there is available white space. Applicants' representative argued that determining whether there is white space available is not merely a determination of the width of the display area of a browser window. In addition, Applicants requested clarification of whether the Examiner cites Votipka for both the embedding and reflowing steps of claim 1 or just one of the steps. The Examiner responded that Votipka teaches the embedding step in either element because the Examiner claims that for a banner has to be embedded to be displayed. In addition, the Examiner stated that the banner is equivalent to

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secondary content and that the web page or web page window is the equivalent of primary content. Applicants asserted that a display area for a web page, or web page window, is distinguishable from the primary content of a web page in that only a portion of the primary content may be displayed within the display area at one time, but the display area may be adjusted to display other portions of the primary content.

Applicants requested clarification in claim 5 of how Votipka teaches a designation that the secondary content is to be *persistently* displayed within *white space* of the document from Votipka's disclosure (col. 3, lines 33-34) of "Then, whenever the user loads a page that includes the banner into their web browser, the browser itself determines..."? The Examiner stated that the term "persistently" just means always and that the banner is always embedded in the web page. Applicants argued that claim 5 does not merely teach embedding the banner, but teaches that the secondary content is persistently *displayed*. "Persistently displayed within white space" means that within the display area the secondary content is always displayed within the available white space. Applicants noted that in Votipka, the banner is embedded in a fixed position within the web page so that if the user scrolls to display a different portion of the web page that does not include the fixed position, the banner is no longer visible; in contrast, claim 5 teaches that the secondary content is persistently displayed so that with scrolling the secondary content is positioned in the white space within the current display area. Applicants agreed with the Examiner that claim 5 may need to be amended to clarify what is meant by "persistently displayed".

Applicants requested clarification in claim 6 of how Votipka teaches retrieving the designation from a database accessible to the viewer program from Votipka's disclosure (col. 4, lines 21-22) of "Banner 400 is implemented as a table that includes both fixed- and variable-width cells." The Examiner stated that Votipka describes a browser accessing a table and that is the equivalent of accessing a database. The Examiner did not provide clarification of how "the designation" is retrieved from a database.

Applicants requested clarification in claim 26 of how Votipka specifically teaches a server sending a rendered document with the secondary content already embedded to the client for display. In particular, Applicants noted that the Examiner rejects claim

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26 on the same grounds as claim 1, but without an indication of how Votipka teaches the distinguishable elements in claim 26. The Examiner stated that the server sending a rendered document with the secondary content already embedded is a conventional feature because elements are embedded in documents. Applicants noted that even if the Examiner's assertion is correct, when claim 26 is viewed as a whole, it is not a conventional feature for a server to send a rendered document with secondary content already embedded to the client for display, where the secondary content is embedded in the available white space of the document.

Applicants requested clarification in claim 28 of how Votipka specifically teaches the element of "overlaying the secondary content over a portion of the primary content for a period of time if it is determined that there is no available white space to accommodate the secondary content." The Examiner responded that because the overlaying element is included in a list of options and the Examiner rejected the embedding step in the list, the Examiner need not address the overlaying element.

### *Drawing Objections*

With regard to the drawings, the Examiner states:

> Figure 1 should be designated by a legend such as —Prior Art— because only that which is old is illustrated. See MPEP 608.02(g).
> The Examiner notes that "Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office Action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the application will be notified and informed of any required corrective action in the next Office Action.

Applicants file corrected drawings herewith, each labeled as "Replacement Sheet" and Figure 1 including a notation as "Prior Art". Applicants respectfully request withdrawal of the drawing object in view of the corrected drawings filed herewith.

### *35 USC 101*

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The Examiner rejects claims 12 and 29 under 35 USC 101 as directed to non-statutory subject matter. In the rejection, the Examiner states:

Claims 12 and 29 are not limited to tangible embodiments. The claim recited "A computer program, on a computer usable medium, having program codes for rendering a document on a display, comprising..." is nonstatutory. Since claim 12 recited "A computer program..." is just limited to a functional descriptive materials" consists of computer program per se, instead of being defined as including tangible embodiments (i.e., a computer readable storage medium such as memory device, storage medium, etc. (excluding transmission media such light waves...as defined in the specification of instant application at page 14 lines 17-21)). As such, the claim is not limited to statutory subject matter and is therefore nonstatutory.

To overcome this type of 101 rejection, examiner suggests applicants to amend the claim to include computer usable storage medium to store computer codes (for example, the claim should be amended as "A computer program, on a computer readable storage medium, having program code means for rendering a document on a display, comprising:" see MPEP 2106 section V. [...] under subsection 1. [Office Action, pp. 2-3]

Applicants respectfully traverse the rejection under 101 in view of the Updated Guidelines. The Interim Guidelines themselves state:

> These Guidelines do not constitute substantive rulemaking and hence do not have the force and effect of law. These Guidelines have been designed to assist USPTO personnel in analyzing claimed subject matter for compliance with substantive law. Rejections will be based upon the substantive law and it is these rejections which are appealable.

During the Interview, the Examiner directed Applicants to a sentence within section (c) Electro-Magnetic Signals which states:

> Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

Applicants, however, note that following, in the same section, the Guidelines state:
> On the other hand, from a technological standpoint, a signal encoded with functional descriptive material is similar to a computer-

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readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal.

These interim guidelines propose that such signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101. Public comment is sought for further evaluation of this question.

Thus, Applicants respectfully note that the question of whether a signal based encoded with functional descriptive material, as in claims 12 and 29, is eligible for patent protection under 35 USC 101 is a question opened for public comment and further evaluation. Since the question is one that is unresolved, Applicants respectfully request that the Examiner remove the rejection which is based only on a proposed interpretation of 35 USC 101 and allow claims 12 and 29.

## 35 USC 102(a)

Claims 1-8, 12-16, 19-24, and 26-30 stand rejected under 35 USC 102(a) as being anticipated by Votipka (US Patent 6,185,589). [Office Action, p. 3]

## Alleged Anticipation

Applicants respectfully assert that claims 1-8, 12-16, 19-24, and 26-30 are not anticipated by Votipka and therefore the claims should be allowed. In particular, Applicants note that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksma*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because Votipka does not teach each and every element of claims 1-8, 12-16, 19-24, and 26-30 or enable each and every element of these claims, these claims are not anticipated, the rejection should be withdrawn, and the claims should be allowed.

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## Claims 1, 12, and 19

Claim 1, which is representative of independent computer program claim 12 and independent system claim 19 in grounds of rejection, reads as follows:

> 1.    (Currently Amended)  A method for rendering a document on a display utilizing a viewer program running on a computer system, comprising:
>
> receiving primary content of the document to be displayed;
>
> identifying secondary content to be displayed in conjunction with the primary content;
>
> determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content; and
>
> performing at least one of:
>
> embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content; and
>
> responsive to determining the white space is not available, reflowing the primary content to form suitable white space in the displayed area and embedding the secondary content in the suitable white space formed.

Applicants respectfully assert that Votipka does not teach or enable each and every element of claim 1 because Bloch does not teach or enable *determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content, embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content, and responsive to determining the white space is not available, reflowing the primary content to form suitable white space in the display area to accommodate the secondary content and embedding the secondary content in the suitable white space formed.*

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## Votipka does not teach or enable *determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content*

In the rejection of claims 1, 12, and 19, the Examiner cites Votipka, col. 3, lines 33-35 as reading on *receiving primary content of the document to be displayed, identifying secondary content to be displayed in conjunction with the primary content, and determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content.*
[Office Action, p. 4]

In particular, the Examiner asserts that Votipka's disclosure of "a user loads a web page" reads on *receiving primary content of the document to be displayed,* that "a page that includes the banner" reads on *identifying secondary content to be displayed in conjunction with the primary content,* and that "the browser itself determines the width of the display area" reads on *determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content.*

Votipka, col. 2, line 66 – col. 3, line 2 states "The present invention allows designers of web pages to design horizontal visual banner devices that can be reused for different window widths without requiring a separate banner for each width." Votipka, col. 3, lines 33-36 read:

> Then, whenever the user loads a page that includes the banner into their web browser, the browser itself determines the width of the display area and automatically adjusts the size of the table to fit the display area.

First, Applicants respectfully assert that Votipka does not teach or enable *determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content* because Votipka does not teach or enable determining the available white space within a display area. Votipka clearly only discloses that a browser measures the width of a display area of a browser window. Votipka, col. 2, line 66-col. 3, line 2 and col. 3, lines 33-36. Applicants respectfully assert that Votipka's description of taking a width measurement

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of a display area of a browser window does not teach determining the available white space within the display area of a browser window and in particular does not teach determining the available white space within the primary content as displayed within the display area.

As to the definition of "white space", Applicants respectfully assert that if "white space" is given a an ordinary or customary meaning as available in dictionary definitions, examples of definitions include (1) "space on a page or poster not covered by print or graphic matter" *The American Heritage Dictionary of the English Language*, Fourth Edition, Copyright 2000 by Houghton Mifflin Company; (2) "empty space, space around an object or form" *Webster's New Millenium Dictionary of English*, copyright 2003-2005, Lexico Publishing Group, LLC. *See* MPEP 2106, "Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003). In view of the definition of "white space", determining available white space is not enabled by a browser that detects the width of the browser window; determining available white space requires both identifying the areas of a display area not covered by the primary content of the web page and then measuring those areas. Further, in view of claim 1 when considering every limitation, determining whether there is available white space requires determining the available white space within the primary content of the document when displayed within a display area, which is not merely a measurement of the width of the display area. See MPEP 2106 ("When evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. at 188-89, 209 USPQ at 9.") Therefore, in view of the ordinary and customary meaning of "white space" and claim 1 when viewed as a whole, it is clear that merely determining the width of a browser window display area as disclosed by Votipka does not teach and particularly does not enable determining the available white space within a display area or enable determining the available white space within the primary content as displayed within the

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display area. Because Votipka does not teach at least one element of claims 1, 12, and 19, Votipka does not anticipate claims 1, 12, and 19 and the claims should be allowed.

Second, Applicants respectfully assert that Votipka does not teach or enable *determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content* because Votipka does not teach or enable determining whether there is available white space to accommodate the secondary content within the portion of the primary content of a document currently displayed within the display area. Votipka describes that the browser determines the width of the display area and adjusts the size of the table for the banner to fit within a web page. See Votipka, col. 2, line 66-col. 3, line 2 and col. 3, lines 33-36. Votipka does not describe searching the portion of the web page current displayed within the display area for a space sufficient to accommodate secondary content of a particular size. In contrast, claim 1, when viewed as a whole, teaches determining the available white space just within the primary content currently within the display area and determining whether there is available white space available of sufficient size to fit the secondary content within the display area. In particular, Applicants note that when claim 1 is interpreted in light of the supporting disclosure, such as paragraph 0023 which reads "[s]pecifically, a web browser examines the primary web page content for available white space having a size that will allow the designated content to fit within it", it should be interpreted that for the available white space to accommodate the secondary content the size of the available white space is sufficient to fit the secondary content within it. Therefore, because Votipka only describes resizing a table for the width of a browser window, Votipka does not teach or enable determining whether there is available white space within the primary content as displayed within a display area to accommodate the secondary content. Because Votipka does not teach at least one element of claims 1, 12, and 19, Votipka does not anticipate claims 1, 12, and 19 and the claims should be allowed.

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**Votipka does not teach or enable *embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content,* and *responsive to determining the white space is not available, reflowing the primary content to form suitable white space in the display area to accommodate the secondary content and embedding the secondary content in the suitable white space formed.***

In the rejection of claims 1, 12, and 19, the Examiner cites Votipka, col. 3, lines 15-20 as reading on *performing at least one of embedding the secondary content in the available white space to accommodate the secondary content, and reflowing the primary content to form suitable white space in the display area to accommodate the secondary content and embedding the secondary content in the suitable white space formed.* Col. 3, lines 8-20 read:

> In accordance with the method of the invention, web page banners are constructed in part using HTML tables rather than as a single graphical image. The background image is defined in an HTML table. Each graphical image that in prior art would normally be embedded within the single GIF image is separately overlaid, with a transparent background to allow the table background to remain visible, in a separate fixed-width cell of the table. Empty space regions are defined as transparent variable-width cells and appropriately positioned in the table. The user's browser automatically resizes the variable-width cells to adjust the width of the table to cover the width of the window that displays the web page.

First, with respect to the elements of *embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content and responsive to the white space not being available, reflowing the primary content to form suitable white space in the display area to accommodate the secondary content and embedding the secondary content in the suitable white space formed,* Applicants respectfully assert that Votipka does not teach or enable each and every element because Votipka does not teach or enable embedding the secondary content in either the available white space or the suitable white space formed. Votipka only describes resizing a horizontal banner, that is already embedded within a web page, to fit to the width of the window that displays the web page. Votipka, col. 3, lines 18-23, col. 7. lines 22-45. Votipka does not teach or enable

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embedding a banner in available or suitable white space located within the content currently displayed within the display area, where the available or suitable white space is not used by the primary content displayed within the display area. In contrast, claim 1 teaches that the secondary content is embedded in the available white space or forming suitable white space within the display area and embedding the secondary content in the suitable white space. Either way, because Votipka only teaches resizing an already embedded table when displayed, Votipka does not teach or enable embedding the secondary content in the available white space or suitable white space formed. Because Votipka does not teach at least one element of claims 1, 12, and 19, Votipka does not anticipate claims 1, 12, and 19 and the claims should be allowed.

Second, Applicants note that during the Interview, Applicants' representative requested clarification from the Examiner whether both the embedding and reflowing elements are rejected on the same grounds or whether the Examiner only rejected one of the elements. The Examiner further stated that Votipka describes both the embedding and the reflowing elements because "reflowing content within a browser window to fit the content within the window" is not novel. Applicants disagreed with the Examiner's conclusion that merely because refitting content within a browser window may be known, that claim 1, when each limitation is considered as is required for interpreting the claim and when the claim is viewed as a whole, is taught by what is known. Further, Applicants requested that if the Examiner intended to reject the claim based on what is "well known" in the art, that the Examiner provide proper evidentiary support for such assertions.

Regardless of the Examiner's rejection, Applicants amend claims 1, 12, and 19 to clarify that claims 1, 12, and 19 teach both embedding if the available space is sufficient to accommodate the secondary content and if there is not available space, reflowing the primary content to form suitable white space in the displayed area to accommodate the secondary content and embedding the secondary content in the suitable white space formed. In addition, Applicants amend claims 1, 12, and 19 to clarify that the suitable white space is formed in the display area to accommodate the secondary content.

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In addition, Applicants respectfully assert that Votipka does not teach or enable the element of *responsive to the white space not being available, reflowing the primary content to form suitable white space in the displayed area to accommodate the secondary content and embedding the secondary content in the suitable white space formed*, because Votipka does not teach or enable reflowing the primary content to form suitable white space <u>in the displayed area</u> to accommodate the secondary content. Votipka describes adjusting a banner to the width of a display window. Votipka, col. 3, lines 33-36. There is no teaching in Votipka of reflowing content within a display area and thus there is no teaching in Votipka of reflowing content within a display area to form suitable white space to accommodate the secondary content. In addition, Applicants note that claims 1, 12, and 19 do not merely teach reflowing content within a browser window as asserted by the Examiner in the interview. In fact, the limitation in the claims teach reflowing primary content to form suitable white space in the displayed area and forming that suitable white space to accommodate the secondary content. Therefore, because Votipka does not teach or enable reflowing the primary content to form suitable white space in the displayed area to accommodate the secondary content, Applicants respectfully assert that Votipka does not anticipate claims 1, 12, and 19 and the claims should be allowed.

Claim 12

In addition, with regard to claim 12, the Examiner states that claim 12 "represents a computer program that is parallel to claim 1. Claim 12 does not teach or define any new limitation above claim 1 and therefore is rejected for similar reasons." [Office Action, p. 6] Applicants respectfully assert that merely because claim 12 is a computer program claim similar to claim 1, a rejection solely on the same basis as method claim 1 does not specifically point out how Votipka also teaches the computer program on a computer usable medium having computer program code means for rendering a document on a display. Applicants respectfully assert that because Votipka does not teach or enable a computer usable medium having computer program code means for

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rendering a document on a display, Bloch does not teach or enable at least one element of claim 12 and the claim should be allowed.

**Claims 2-8, 13-16, 20-24**

With regard to claims 2-8, 13-16, and 20-24, Applicants respectfully propose that because Votipka does not anticipate independent claims 1, 12, and 19 upon which these dependent claims rely, Votipka also does not anticipate these dependent claims and the dependent claims should be allowed. In addition, Applicants respectfully assert that Votipka does not teach or enable each element of 2, 4, 5, 13, 14, 20, 21 as will be further discussed, and therefore each of these claims should be allowed.

<u>Claims 2, 13, and 20</u>

Claim 2, which is representative of dependent computer program claim 13 and dependent system claim 20 in grounds of rejection, reads as follows:

> 2.      (Currently Amended)  The method of claim 1 further comprising<u>:</u>
>          receiving a user action to change a <u>portion</u> ~~display~~ of the primary content <u>currently displayed</u> in the display~~ed~~ area; ~~and~~
>          <u>determining whether there is available white space within the portion of primary content currently displayed in the display area to accommodate the secondary content; and</u>
>          <u>embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content; and</u>
>          <u>responsive to determining the white space is not available, reflowing the primary content to form suitable white space in the displayed area and embedding the secondary content in the suitable white space formed.</u>
>          ~~reiterating determining available white space and performing at least one of embedding the secondary content and reflowing the primary content.~~

As to the elements of claims 2, 13, and 20, the Examiner cites Votipka col. 4 lines 12-13 as teaching *receiving a user action to change a display of the primary content in the displayed area* and Votipka col. 4, lines 23-25 as teaching *reiterating determining available white space and performing at least one of embedding the secondary content and reflowing the primary content.* [Office Action, pp. 4, 6, and 7]

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Votipka, col. 4, lines 12-19 read: "Furthermore, if the designer allows the user to adjust the web size in the display, in order to display the banner as the full width of the window down to a minimum threshold, a separate GIF image banner must be created for each possible width between the minimum threshold width and the maximum display width." Votipka, col. 23-25 read: "Variable-width cells have an adjustable width which is determined dynamically by the web browser."

Applicants respectfully assert that while Votipka describes that a user may adjust the size of a display window and that the width of the banner adjusts to the window of the display window, adjusting the width of banner already embedded in a web page to the width of a web page does not teach or enable iteratively determining, for each adjustment to the portion of primary content currently displayed within a display area, the white space available within the portion of primary content currently displayed in the display area to accommodate the secondary content and embedding the secondary content in the available space or reflowing the primary content within the display area to form suitable white space and embedding the secondary content in the suitable white space. In contrast, Applicants have amended claims 2, 13, and 20 to clarify that the portion of the primary content currently displayed in the display area is adjusted. In addition, regardless of the Examiner's assertions, Applicants amend claims 2, 13, and 20 to clarify that responsive to each change in the portion of the content displayed within the display area, iteratively determining the available white space and either embedding the secondary content in the available white space or reflowing the primary content within the display area to form suitable white space and then embedding the secondary content in the suitable white space. The specification supports the clarification throughout, and for example, in paragraph 0023, lines 17-24. Because Votipka does not teach or enable iteratively determining and reembedding secondary content within the primary content currently displayed within a display area, Votipka does not teach each and every limitation of claims 2, 13, and 20 and the claims should be allowed.

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Claim 4

Claim 4 reads:

4.(Original) The method of claim 1 wherein the white space is a
background to the primary content.

The Examiner rejects claim 4 on the basis of Votipka col. 4, lines 29-30. [Office
Action, pp. 5, 6, 7] Votipka, col. 4, lines 29-30 read "A background image is embedded
in the table across background layers 408 of each of cells 402, 404, and 406." Thus,
where Votipka describes that the table defining a banner includes layers to each cell
and that a background image is embedded in the background layers, Votipka describes
that a banner may have background and foreground images. There is no indication that
the background image is considered "white space", but is included within the bounds of
the banner. Further, Applicants respectfully assert that when claims 1 and 4 are
interpreted as a whole, there is primary content and secondary content, the white space
is a background to the primary content and the secondary content is embedded in
available white space. During the interview, with respect to claim 1, the Examiner
stated that the table or banner is interpreted as the secondary content. Applicants
respectfully assert that the Examiner's rejection does not provide a teaching of a
background to primary content or when claim 4 is viewed as a whole, the Examiner's
rejection does not provide a teaching that in determining available white space, that the
white space is determined from the background to the primary content. Therefore,
because Votipka does not teach white space that is a background to the primary
content, Votipka does not teach or enable at least one element of claim 4 and the claim
should be allowed.

Claims 5, 14, and 21

Claim 5, which is representative of dependent computer program claim 14 and
dependent system claim 21 in grounds of rejection, reads as follows:

5.(Currently Amended) The method of claim 1 wherein identifying
secondary content comprises receiving a designation associated with
receiving secondary content indicating that the secondary content is to be

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persistently displayed within white space within the display area regardless of a user action of at least one of adjusting the portion of the primary content currently displayed within the display area and adjusting a size of said display area of the document.

As to the elements of claims 5, 14, and 21, the Examiner cites Votipka, col. 3, lines 33-34. [Office Action, pp. 5, 6, 7] Col. 3, lines 33-34 read: "Then, whenever the user loads a page that includes the banner into their web browser, the browser itself determines the width of the display area and automatically adjusts the size of the table to fit the display area."

Applicants respectfully assert that Votipka does not teach a designation associated with receiving the secondary content indicating that the secondary content is to be persistently displayed within white space because Votipka does not teach secondary content designated to be persistently displayed within white space. First, Applicants note that during the interview, the Examiner stated that the term "persistently" just means always and that the banner is always embedded in the web page. First, Applicants respectfully assert that the Examiner's assertion fails to interpret the scope of claims 5, 14, and 21 in view of the specification and therefore does not ascribe a proper meaning all of the limitations of claims 5, 14, and 21. The Examiner's assertion incorrectly assumes that the only setting available is to always embed secondary content, when in fact, the specification paragraph 0056 describes that a designation can be set that requires the secondary content to always remain visible within white space within the display area "regardless of user actions such as scrolling or resizing of a primary web page frame" or a separate designation can specify that the secondary content is to be displayed overlaying the primary content for a period of time (see paragraphs 0063, 0064). Applicants' specification provides meaning for a designation to persistently display content within the display area versus a designation to only display content within the display area for a particular time period. Second, the Examiner's assertion fails to show how Votipka teaches receiving a designation to persistently display the secondary content within white space. Votipka only describes a width adjustable banner embedded in a web page; a width adjustable banner does not teach or enable receiving a designation indicating that the secondary content is to be

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persistently displayed within white space. Third, Applicants respectfully assert that the limitation of claims 5, 14, and 21 is not that the secondary content is always or constantly embedded as asserted by the Examiner, but that the secondary content is *persistently displayed.* When the claims 5, 14, and 21 are interpreted as a whole with claims 1, 12, and 19, respectively, *persistently displayed within white space* means that within the display area the secondary content is always displayed within available or suitable white space.

For purposes of clarification, regardless of the Examiner's previous assertions, Applicants amend claims 5, 14, and 21 to clarify that the designation requires the secondary content to be *persistently displayed within the white space within the display area regardless of a user action of at least one of adjusting the portion of the primary content currently displayed within the display area and adjusting a size of said display area.* Votipka does not teach or enable a designation that requires the secondary content to always be displayed within the white space available or suitable within the display area and in particular, Votipka does not teach or enable a designation that the secondary content remain displayed within the display area regardless of a user action to adjust the display area, including adjusting the size of the display area or the portion of the primary content currently displayed within the display area. The specification supports the clarifying amendment throughout, and for example, in paragraphs 0023, 0032, 0042, 0049, 0055, and 0056. Therefore, because Votipka fails to teach a designation indicating that secondary content is to always be displayed within the white space within the display area, Votipka does not teach enable at least one element of claims 5, 14, and 21, and the claims should be allowed.

### Claims 26, 27

Claim 26, which is representative of claim 27 in rejection, reads:

> 26.     (Currently Amended) A method for sending a rendered document from a server to a client over a network, comprising:
> receiving primary content of the document to be displayed;
> identifying secondary content to be displayed in conjunction with the primary content;

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> determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content;
> ~~performing at least one of:~~
> embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content; [[and]]
> <u>responsive to determining the white space is not available,</u> reflowing the primary content to form suitable white space in the displayed area and embedding the secondary content in the suitable white space formed; and
> sending the document with the embedded secondary content to the client for display.

The Examiner rejects claims 26 and 27 by stating that claims 26 and 27 do "not teach or define any new limitation above claim 1 and therefore is rejected for similar reasons." [Office Action, p. 7] Applicants respectfully disagree with the Examiner's assessment that claims 26 and 27 do not teach any new limitation above claim 1. Claim 26, for example, specifically includes elements of "a method for sending a rendered document from a server to a client over a network" and "sending the document with the embedded secondary content to the client for display" which are new limitations distinguishable from claim 1.

As to these new limitations, the Examiner does not point to any teaching in Votipka of a server sending a rendered document with the embedded secondary content. In addition, Votipka does not provide any teaching or enablement for sending the document with the embedded secondary content from the server to the client for display. Votipka only describes a web browser loading a web page performing the adjustment to the width of the banner to fit the width of the display area. Votipka does not describe a server embedding the secondary content in a document and sending it to the client. Further, when each of claims 26 and 27 are viewed as a whole, the claims teach that a server sends a rendered document with secondary content already embedded, where the secondary content is embedded in available white space or suitable white space formed within the display area for the document. Votipka does not teach, nor does the Examiner point to any teaching of claims 26 and 27 when each is viewed as a whole. Therefore, because Votipka does not teach at least one element of

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claims 26 and 27, Votipka does not anticipate claim 26 or 27 and the claims should be allowed.

Applicants note that during the Interview, the Examiner stated that the server sending a rendered document with the secondary content already embedded is a conventional feature because elements are embedded in documents. Applicants respectfully assert that even if the Examiner's assertion were to be correct, when claims 26 or 27 are viewed as a whole, it is not a conventional feature for a server to send a rendered document with secondary content already embedded to the client for display, where the secondary content is embedded in the available white space or suitable white space of the document. In addition, Applicants respectfully assert that if the Examiner is to base the rejection on a "conventional feature" the Examiner is essentially basing the rejection of what is well known in the art. Applicants request that if the Examiner intends to reject claims 26 and 27 in on such a basis, that the Examiner provide proper evidentiary support for a rejection based on what is well known in the art, as is required by MPEP 2144.03.

In addition, Applicants note that claims 26 and 27 are amended in a similar manner as claim 1 and assert that at least with respect to the elements in common between claims 1 and claims 26 and 27, Votipka does not anticipate claims 26 and 27 for the same reasons that Votipka does not anticipate claim 1.

**Claims 28, 29, and 30**

Claim 28, which is representative of independent computer program claim 29 and independent system claim 30 in grounds of rejection, reads as follows:

> 28. (Currently Amended) A method for rendering a fixed content
> document on a display utilizing a viewer program running on a computer
> system, comprising:
> 　　　receiving primary content of the document to be displayed;
> 　　　identifying secondary content to be displayed in conjunction with
> the primary content;
> 　　　determining whether there is available white space within the
> primary content, when displayed within a display area, to accommodate
> the secondary content; [[and]]
> 　　　performing at least one of:

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> embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content; and
> overlaying the secondary content over a portion of the primary content for a period of time if it is determined that there is no available white space to accommodate the secondary content.

The Examiner rejects claims 28, 29, and 30 by stating that these claims do "not teach or define any new limitation above claim 1 and therefore is rejected for similar reasons." [Office Action, p. 8] Applicants respectfully disagree with the Examiner's assessment that claims 28, 29, and 30 do not teach any new limitation above claim 1. In addition, Applicants amend claims 28, 29, and 30 to clarify that the claims teach both embedding the secondary content and overlaying the secondary content.

As to the elements of claims 28, 29, and 30 Applicants assert that at least with respect to the elements in common between claims 1 and claims 28, 29, and 30, Votipka does not anticipate claims 28, 29, and 30 for the same reasons that Votipka does not anticipate claim 1. In addition, with respect to the element of "overlaying the secondary content over a portion of the primary content for a period of time if it is determined that there is no available white space to accommodate the secondary content", Applicants respectfully assert that Votipka does not teach this element and therefore claims 28, 29, and 30 are not anticipated and the claims should be allowed.

### *Lack of Obviousness under 35 USC § 103(a)*

## Claims 9-10, 18, and 25 are not obvious under Votipka in view of Admitted Prior Art (APA)

Claims 9-10, 18, and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Votipka in view of Admitted Prior Art (APA). [Office Action, pp. 8, 9] First, Applicants respectfully assert that because claims 9-10, 18, and 25 are dependent claims of independent claims 1, 12, and 19 which are not anticipated by Votipka, claims 9-10, 18, and 25 should be allowed. In addition, Applicants respectfully assert that

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claims 9, 18, and 25 are not unpatentable over Votipka in view of APA and therefore should be allowed.

Claim 9, which is representative of dependent computer program claim 18 and dependent system claim 25 in grounds of rejection, reads as follows:

> 9.(Currently Amended) The method of claim 1 wherein the step of determining whether there is available white space further comprises determining the areas of the data elements in the document used through a Document Object Model Interface.

In particular, in the rejection of claims 9, 18, and 25, the Examiner states:

> Votipka does not explicitly teach determining the areas of the data elements used through a Document Object Model Interface. APA teaches determining the areas of the data elements used through a Document Object Model Interface (page 4, lines 1-12). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Document Object Model Interface of APA in the process of rendering a document on a display in Votipka. One would be motivated to do so to allow the content to be dynamically accessed and updated. [Office Action, pp. 8-9]

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Applicants note that claims 9, 18, and 25 are amended to clarify that the data elements are in the document, and thus are part of the primary content, as supported in the specification in paragraph 0046.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants continue to assert that Votipka does not teach determining whether there is available white space. Further APA does not teach determining whether there is available white space, but only determining the areas of the data elements. Thus, because neither Votipka or APA separately teaches determining whether there is available white space, Votipka in combination with APA also does not teach determining whether there is available white space. In addition, because determining whether there is available white space is not taught or suggested by Votipka or APA, separately or in combination, determining whether available white

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space by determining the areas of the data elements used through a Document Object Model Interface is also not taught by Votipka or APA, separately or in combination.

In addition, to establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the references. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). In particular, the teaching, suggestion or motivation to combine or modify the teachings of the prior art to produce the claimed invention must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Applicants respectfully assert that because Votipka, col. 3, lines 33-36, only describes determining the width of a display area and adjusting the width of an embedded banner to the width of the display area, there is no suggestion or motivation to modify Votipka to further teach determining the white space within the display area and determining whether the available white space can accommodate the secondary element. Further, there is no suggestion or motivation to modify Votipka's teaching of determining the width of the display area by determining the areas of the data elements of the web page; Votipka only describes aligning the edges of the banner to the edges of the browser window display area. Further, merely because the areas of data elements of a document can be determined through a Document Object Model Interface, there is not a suggestion to modify the description of determining the areas of the data elements to further teach determining the areas of the data elements so that the remaining areas can be determined as white space.

Therefore, because Votipka in view of APA do not teach or suggest all of the claimed limitations and there is no suggestion or motivation to modify the references,

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prima facie obviousness is not established for claims 9, 18, and 25 and the claims should be allowed.

## Claims 11 and 17 are not obvious under Votipka in view of Ballard

Claims 11 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Votipka in view of Ballard [Office Action, pp. 9, 10] Applicants respectfully assert that because claims 11 and 17 are dependent claims of independent claims 1 and 12 which are not anticipated by Votipka, claims 11 and 17 should be allowed. In addition, Applicants respectfully assert that

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## Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, Applicants respectfully request withdrawal of the rejection of claims 1-30 and respectfully request a timely issuance of a notice of allowance for these claims. In addition, if the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,

m 12/20/05

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